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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,929	03/09/2001	Charles Patrick Thacker	03797.00092	3449

28319 7590 02/23/2004

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EXAMINER

LIU, MING HUN

ART UNIT	PAPER NUMBER
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2675

10

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/801,929

Applicant(s)

THACKER ET AL.

Examiner

Ming-Hun Liu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.                                                |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,262,719 to Bi et al. The detailed explanations of the rejections are found in the first office action paper number 6, dated 12-16-2002.

In response to the applicant's statement on page 13, lines 9-11, stating that Bi's reference fails to indicate that the icons are always present, such a claim may be true, however one skilled in the art would have found it obvious to incorporate a reveal routine to the hot icon area if such a feature was desired due to the extreme conventionality of such a function. Examples of this reveal routine are is the Microsoft Windows right click menu reveal and the mouse over reveal function. It would have been obvious to one skilled in the art to incorporate such a feature because of its power saving and display space conserving potential.

In reference to claims 25-28, the new limitations of displaying the interface controls near a point of contact between said digitizing pen and digitized writing surface is obvious to one skilled in the art. It is extremely conventional for input dialogue box to appear at the location of stylus contact. Several Windows and stylus-based platforms utilize this appearance feature. One skilled in the art would have been motivated to incorporate such an appearance feature to conserve display space and maintain the conventionality of such a common computer based feature.

### ***Response to Arguments***

2. Applicant's arguments filed 12/15/2003 have been fully considered but they are not persuasive. The "mouse over" or "stylus over" accompanies by a gesture to reveal a menu is

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well known in the art as demonstrated by the Moran patent. It has been known in the public domain since March of 1996, with the inception of the idea preceding the filing date of 1993 as made apparent in *the Background of the Invention* section of the disclosure. As Moran establishes, the idea of a gesture invoking a pop-up menu has been known in the art for at least 10 years, a practice that is certainly well known in the art.

### ***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ming-Hun Liu whose telephone number is 703-305-8488. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mancuso can be reached on 703-305-3885. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

Ming-Hun Liu

February 12, 2004

  
**DENNIS-DOON CHOW**  
**PRIMARY EXAMINER**